

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 3-56 are pending. Claims 3-5, 10-12, and 18-46 are withdrawn from consideration pursuant as being directed to a non-elected invention. Claims 6, 7, and 13-16 are amended. The specification and original claims provide support for the claim amendments. Accordingly, no new matter has been added.

With respect to deleting the species "coelenteramid" in the amended claims and adding the species "coelenteramid analog," Applicant would like to thank Examiner Haq for speaking with Applicant's representatives, Rebecca McNeill and Shing-Yi Cheng, on April 5, 2010, regarding MPEP § 821.03. MPEP § 821.03 prohibits entering an amendment that cancels all claims drawn to the elected invention and presents only claims drawn to the nonelected invention; however, it further states this prohibition "is not applicable where a provisional election of a single species was made in accordance with MPEP § 803.02 and applicant amends the claims such that the elected species is cancelled." Applicants note that the requirement for a species election of a coelenteramid was made pursuant to MPEP § 803.02. See Restriction Requirement dated January 27, 2009, page 6. Thus, Applicant submits that the present Amendment should be entered.

Applicant also requests clarification of the record regarding claim 27. Applicant notes that claim 27 was included in both Group I and Group VI in the Requirement for Restriction/Election dated January 27, 2009.

**II. REJECTION UNDER 35 U.S.C. § 102(b)**

The Office makes the following rejections under 35 U.S.C. § 102(b):

- (1) Claims 6-9 and 13-17 as allegedly anticipated by Kurose *et al.*, *Bioluminescence of the Ca<sup>2+</sup> -Binding Photoprotein Aequorin After Cysteine Modification*, Proc. Natl. Acad. Sci., Vol. 86, pp. 80-84 (1989) ("Kurose") (Final Office Action dated January 6, 2010, pages 2-5);
- (2) claims 6-9 and 14-17 as allegedly anticipated by Inouye *et al.*, Expression of the Gene and Fluorescence Characteristics of the Recombinant Protein, FEBS Letters, Vol. 341, pp. 277-280 (1994) ("Inouye") (*Id.* at 5-8); and
- (3) claims 6-9 and 14-17 as allegedly anticipated by Kojima *et al.*, *Mechanism of the Redox Reaction of Aequorea Green Fluorescent Protein (GFP)*, Tetrahedron Letters, Vol. 38, No. 16, pp. 2875-2878 (1997) ("Kojima") (*Id.* at 8-11).

Applicant disagrees and respectfully traverses the rejection for at least the reasons of record and the following additional reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2132 (citation omitted). In this case, none of the cited references (Kurose, Inouye, or Kojima) teach every element of the instant claims, at least because those references do not teach "[a] fluorescent protein having chemiluminescence activity, comprising . . . a coelenteramid analog . . ." Thus, none of the cited references anticipate the instant claims and Applicant respectfully requests that the rejection be withdrawn.

### III. NONSTATUTORY OBVIOUSNESS-TYPE DOUBLE PATENTING

The Office rejects claims 6-9 and 14-17 on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claims 3-8 of U.S. Patent No. 7,396,655 ("the '655 patent"). Final Office Action dated January 6, 2010,

pages 11-12. Applicant respectfully requests that the Office hold this rejection in abeyance until such time as a conflicting claim is found otherwise allowable. Applicant will take appropriate action at that time.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: April 6, 2010

By: Mary K. Jones  
Mary K. Jones  
Reg. No. 63,766  
Phone: (202) 408-4438  
Email: maryk.jones@finnegan.com